THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DIETRICH W. GRABIS

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Appeal No. 96-1619
Application 08/263,015[1]

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ON BRIEF

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Before HAIRSTON, JERRY SMITH and CARMICHAEL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

_____

[1] Application for patent filed June 20, 1994. According to the appellant, this application is a continuation of 08/047,165, filed April 14, 1993, now abandoned; which is a continuation of 07/729,949, filed July 15, 1991, now abandoned.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 22-26, which constitute all the claims remaining in the application. An amendment after final rejection was filed on May 4, 1995 and was entered by the examiner.

The invention pertains to a method for forming a shield and attaching it to the faceplate of a cathode ray tube. The shield is formed from a transparent flat plastic substrate having a thickness between 0.8mm and 1.2mm. The plastic substrate is coated with a filter. The substrate is attached to the faceplate of the cathode ray tube which causes it to bend to substantially conform to the shape of the faceplate.

Representative claim 22 is reproduced as follows:

22. A method for shielding a cathode ray tube having a curved faceplate comprising the following steps:

providing a substantially flat transparent plastic substrate having a thickness between about 0.8mm and 1.2mm, said plastic substrate being composed of a polycarbonate or acrylic material which when bent to conform to said curved faceplate will bend without fracturing and also when bent remains wrinkle free to preserve its optical properties;

coating said flat plastic substrate on at least one surface to provide a filter;

affixing said coated substrate to said faceplate causing it to bend to substantially conform to the surface of said curved faceplate.

The examiner relies on the following references:

Moritz et al. (Moritz)	3,582,189	June 01, 1971
Dickie et al. (Dickie)	4,686,576	Aug. 11, 1987
Kuhlman et al. (Kuhlman)	4,910,090	Mar. 20, 1990

Claims 22-26 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention. Claims 22-26 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Kuhlman in view of Dickie or Moritz.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of obviousness

relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claims 22-26 particularly point out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 22-26. Accordingly, we reverse.

We consider first the rejection of claims 22-26 under the second paragraph of 35 U.S.C. § 112. The examiner's rejection states the following:

> In claim 22, "said plastic substrate being composed of a polycarbonate or acrylic material which when bent to conform to said curved faceplate will bend without fracturing and also when bent remains wrinkle free to preserve its optical properties" is a desired

> result which does not state/claim what type of or how the material is designed for performing the result [answer, page 3].

Appellant did not specifically respond to this rejection in the original brief, but appellant did respond in the reply brief which was entered by the examiner [Paper #31]. Appellant responds that the examiner has admitted that only routine experimentation would be needed to achieve the claimed properties, and the language in the claim is complementary to the narrow thickness range recited in the claims [reply brief, page 2].

Although appellant's reference to routine experimentation may seem misplaced in responding to a rejection under the second paragraph of 35 U.S.C. § 112, it is appropriate here because the last portion of the rejection quoted above seems to question whether the material has been adequately disclosed. To the extent that the examiner's rejection may be viewed as a challenge to the sufficiency of the disclosure, we conclude that the examiner has presented no evidence or analysis in support of this contention.

In considering the second paragraph of 35 U.S.C. § 112, the general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

We find the recitation in lines 4-8 of claim 22 to clearly recite a physical property of the material, and the artisan would understand which materials meet this property. Therefore, the artisan would have recognized the metes and bounds of the invention recited in claim 22. Accordingly, the rejection of claims 22-26 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 22-26 under 35 U.S.C. § 103 as unpatentable over the teachings of Kuhlman in view of Dickie or Moritz. Appellant has indicated that the

claims on appeal stand or fall together as a single group [brief, page 3]. Therefore, all contested claims stand or fall together. See In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will only consider the rejection against independent claim 22 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.),

cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Kuhlman teaches the making of a shield for the faceplate of a cathode ray tube. The shield of Kuhlman is made from a plastic material composed of polycarbonate or acrylic having a thickness between 1 and 50 mils (.0254mm to 1.27mm). The plastic material is coated with a filter layer and a conductive layer. The coated material is then thermally formed to conform to the specific dimensions of a desired faceplate. Kuhlman does not disclose the manner of attaching the formed shield to the faceplate of a CRT.

Dickie and Moritz were cited by the examiner as examples of using a bezel to affix a shield to the faceplate of a CRT. It is the position of the examiner that the Kuhlman

shield is inherently flexible, and if the Kuhlman shield were attached to a faceplate by a bezel as taught by Dickie or Moritz, then the Kuhlman shield would inherently bend to conform to the shape of the faceplate [answer, pages 4-6].

Appellant argues that there is no evidence that the shield in Kuhlman is inherently flexible because the shield in Kuhlman is shaped by thermal forming of the shield using a die press, or applied pressure [brief, page 4]. We agree with appellant that there is no evidence on this record that the preformed shield in Kuhlman retains its flexibility after it has been heated and formed and is ready for attachment to the faceplate of a CRT. Since the shield in Kuhlman is designed to be preformed to the shape of the faceplate before attachment, there would be no reason why it needs to be flexible. We find it incredible to assume that Kuhlman goes to the trouble to thermoform his shield at high temperatures if the material was naturally flexible at the time it is placed on the faceplate. Thus, we find no evidence on this record that the coated substrate of Kuhlman will be caused to bend as the result of being affixed to the faceplate of a CRT as recited in claim 22.

Appellant also argues that the claimed range of substrate thicknesses represents a narrow range in which the invention unexpectedly works. According to appellant, the Kuhlman substrate does not have the property that "when bent to conform to said curved faceplate [it] will bend without fracturing and also when bent remains wrinkle free to preserve its optical properties" as recited in claim 22. There is evidence on this record that the thermoformed shield of Kuhlman will crack when bent. Based upon the examiner's rejection of the claim under the second paragraph of 35 U.S.C. § 112, the examiner noted that "no patentable weight" had been afforded this recitation in the claim [answer, page 3].

It was error for the examiner to ignore this limitation of claim 22. As we noted above in the discussion of the rejection under Section 112, the properties of the material recited in claim 22 are clear and such properties cannot be ignored by the examiner. The examiner has failed to convince us that the preformed shield in Kuhlman is "inherently flexible" when attached to a faceplate and would have the claimed non-fracture and wrinkle free properties at this time. Thus, the examiner has failed to establish a prima

facie case of the obviousness of independent claim 22. Since all the claims stand or fall together, we do not sustain the rejection of claims 22-26 under 35 U.S.C. § 103.

In summary, we have not sustained the rejection of claims 22-26 under either 35 U.S.C. § 112 or § 103. Accordingly, the decision of the examiner rejecting claims 22-26 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)

) BOARD OF PATENT
JERRY SMITH)
Administrative Patent Judge) APPEALS AND
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